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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,302	12/01/2003	David L. Powell	136089/90 (MHM 15129US01)	2838
23446 7590 01/18/2008 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER CORBETT, JOHN M	
			ART UNIT 2882	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/725,302

Applicant(s)

POWELL, DAVID L.

Examiner

John M. Corbett

Art Unit

2882

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC § 112 second paragraph rejection of claims 1-10 and 19-24.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-29.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


EDWARD J. GLICK
SUPERVISORY PATENT EXAMINER

Continuation of 11.

Applicant's arguments, see page 9, lines 4-5, filed 19 December 2007, with respect to claim 11 have been fully considered and are persuasive. The claim objection of claims 11-18 has been withdrawn.

Applicant's arguments see page 9, lines 13-14, filed 19 December 2007, with respect to claims 1 and 19 have been fully considered and are persuasive. The 35 U.S.C. 112 second paragraph rejection of claims 1-10 and 19-24 has been withdrawn.

The Examiner notes that the Applicant has not made similar amendments to independent claim 25. Therefore, the 35 U.S.C. 112 second paragraph rejection of claims 25-26 remain. Claims 27-29 remain rejected by virtue of their dependency.

Applicant's arguments filed 19 December 2007 have been considered but are not persuasive.

I. Claim Rejections Under 35 USC § 103(a)

A. The Proposed Combination Of References Does Not Render Claims 1, 6-7, and 9-10 Unpatentable.

1. Regarding applicant's arguments that "There is no suggestion or motivation to combine ITSR with other references"

With respect to claims 1, 6-7, and 9-10, the applicant argues the rejection of the claims employs hindsight reasoning. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to claims 1, 6-7, and 9-10, the applicant argues that there is no suggestion within the other references or within the knowledge of the skill in the art for a person of ordinary skill, when attempting to solve the problem of cooling a medical imaging system, to look to an industrial x-ray system ... [which] is non-analogous art. The Examiner disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Baertsch clearly teaches that x-ray imaging systems are routinely used in both medical and industrial applications (Paragraph 4). Additionally, as cited as pertinent prior art in the Final Rejection mailed on 14 June 2007, Feldkamp et al. ("Practical cone-beam algorithm") further illustrates x-ray systems for both medical and industrial use (Page 612, Col. 1, lines 6-10 and Page 616, Col. 1, lines 1-4), thus showing that these systems are analogous in the art. Accordingly, one of ordinary skill in the art would have found it obvious to look to the industrial x-ray imaging art to solve a problem in the medical x-ray imaging art.

2. Regarding applicant's arguments that "The Proposed Combination Of Art Does Not Disclose All Of The Elements Of The Claims"

a) Regarding applicant's arguments that "Dilick Does Not Disclose 'an auxiliary module removably connected to said medical imaging device having a cooling unit'"

This argument was not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The secondary reference Dilick was applied under 35 U.S.C. 103(a), not 35 U.S.C. 102. As stated in the 35 U.S.C. 103(a) rejection of claim 1 above, Dilick was relied upon only for teaching removably connecting to said imaging device. ITSR in view of Baertsch et al. and Burke et al. was relied upon for everything else. Accordingly, the combination of references does suggest an auxiliary module (ITSR) removably (Dilick) connected (ITSR) to said medical (Baertsch) imaging device (ITSR) having a cooling unit (ITSR). As a result, the Applicant's arguments are not persuasive. Dilick still applies as prior art and the claims remain rejected.

B. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claims 2-5 Unpatentable"

The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

C. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claim 8 Unpatentable"

The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

D. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claims 11-17 Unpatentable"

With respect to claims 11-17, the applicant argues, "ITSR is non-analogous art to which a person of ordinary skill in the art would not be led". The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

1. Regarding applicant's arguments that "Yahata Does Not Disclose 'an auxiliary module having a booster battery pack, ... wherein said auxiliary module is separate, distinct, and removably connected directly to said medical imaging device'"

This argument is not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The secondary reference *Yahata et al.* was applied under 35 U.S.C. 103(a), not 35 U.S.C. 102. As stated in the 35 U.S.C. 103(a) rejection of claim 11 above, *Yahata et al.* was relied upon only for teaching a booster battery pack (5), wherein said booster battery pack is configured to be electrically connected to said medical imaging device (Figures 2 and 3) in order to provide additional power to the medical imaging device (Col. 4, lines 58-62). *ITSR* in view of *Baertsch et al.* and *Muchowicz et al.* was relied upon for everything else. Accordingly, the combination of references does suggest an auxiliary module (*ITSR*) having a booster battery pack (*Yahata et al.*) ... wherein said auxiliary module is separate (*ITSR*), distinct (*ITSR*), and removably (*Muchowicz et al.*) connected (*ITSR*) directly (*ITSR*) to said medical (*Baertsch et al.*) imaging device (*ITSR*). As a result, the Applicant's arguments are not persuasive. *Yahata et al.* still applies as prior art and the claims remain rejected.

2. Regarding applicant's arguments that "Muchowicz Does Not Disclose a 'an auxiliary module having a booster battery pack,... wherein said auxiliary module is separate, distinct, and removably connected directly to said medical imaging device'"

This argument is not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The secondary reference *Muchowicz et al.* was applied under 35 U.S.C. 103(a), not 35 U.S.C. 102. As stated in the 35 U.S.C. 103(a) rejection of claim 11 above, *Muchowicz et al.* was relied upon only for teaching removably connecting to said imaging device (Col. 2, lines 48-52). *ITSR* in view of *Baertsch et al.* and *Yahata et al.* was relied upon for everything else. Accordingly, the combination of references does suggest an auxiliary module (*ITSR*) having a booster battery pack (*Muchowicz et al.*),... wherein said auxiliary module is separate (*ITSR*), distinct (*ITSR*), and removably (*Muchowicz et al.*) connected (*ITSR*) directly (*ITSR*) to said medical (*Baertsch et al.*) imaging device (*ITSR*). As a result, the Applicant's arguments are not persuasive. *Yahata et al.* still applies as prior art and the claims remain rejected.

E. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claim 18 Unpatentable"

The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

F. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claims 19-24 Unpatentable"

The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

G. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claims 25-28 Unpatentable"

The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

H. Regarding applicant's arguments that "The Proposed Combination Of References Does Not Render Claim 29 Unpatentable"

The Examiner disagrees with the applicant's arguments for the same reasons set forth above.

Applicant should keep in mind the following court decisions when evaluating and considering the proposed combination when evaluating the ordinary skill in the art set forth in an obviousness-type rejection under 35 U.S.C. § 103:

The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. See, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Also, see *In re Mapelsden*, 51 CCPA 1123, 329 F.2d 321, 141 USPQ 30 (CCPA 1964), and *In re Henley*, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (CCPA 1956). Further, the question in a rejection for obviousness on a combination of references is what the secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in the basic reference structure. See, *In re Richman*, 165 USPQ 509 (CCPA 1970). Thus, we would note that it is well settled that the test of obviousness is not whether the features of one reference can be bodily incorporated into the structure of another and proper inquiry should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would suggest to one skilled in the art the modifications called for by the claims. See, *In re Van Beckum*, 169 USPQ 47 (CCPA 1971). Therefore, the issue lies in what the combination of references makes obvious to the person of ordinary skill and not whether a feature of one reference can be bodily incorporated in the other to produced the subject matter claimed. See, *In re Henley*, op. cit.

Applicant should also keep in mind the following court decisions when evaluating and when evaluating the ordinary skill in the art: We reach our conclusion further in view of the fact that skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). The prior art may be properly evaluated for reasonable inferences which one skilled in the art would draw therefrom, and not just for their specific, express teachings. *In re Shepard*, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). Furthermore, artisans must be presumed to know something about the art, apart from what the references disclose. *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977). And finally, a reference must be considered under 35 U.S.C. § 103 not only for what it expressly teaches but also for what it fairly suggests. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979).

In conclusion, the Applicant's arguments are not persuasive and the claims remain rejected.